

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claim 21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner is unclear as to the meaning of the phrase “wherein the pair of junctions disposed about the first rocking axis are formed integrally with the parallel flat portions so as not to project into a bore of the distal end portion.”

In response, claim 21 has been amended to clarify that the pair of junctions are disposed about the second rocking axis and formed so as not to project into a bore of the distal end portion. Furthermore, new claim 22 has been added to recite a pair of supporting pins disposed about the first rocking axis and formed integrally with the parallel flat portions so as not to project into a bore of the distal end portion. New claim 22 is fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 22.

Accordingly, it is respectfully requested that the rejection of claim 21 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 1, 6, 7, 16, 17 and 20 under 35 U.S.C. § 102(a) as being anticipated by JP 02000279418A to Suzuki (hereinafter “Suzuki”). Additionally, the Examiner rejects claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki. Furthermore, the Examiner rejects claims 10 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent No. 6,066,102 to Townsend et al., (hereinafter “Townsend”). Lastly, the Examiner rejects claim 19 under 35

U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent No. 6,110,127 to Suzuki, (hereinafter “Suzuki ‘127”).

In response, Applicants respectfully traverse the Examiner’s rejections under 35 U.S.C. §§ 102(a) and 103(a) for at least the reasons set forth below.

The Examiner indicates that *Suzuki* discloses “a pair of junctions 100, which...by pins 103a, 103b, the junctions being situated substantially on a reference plane passing through the longitudinal axis... parallel to the second rocking axis... and open”.

The Examiner, in the previous Office Action, has specified a rocking pin with a reference numeral 23a and for the outstanding Office Action, has specified pins with reference numerals 103a and 103b. Thus, Applicants assume that the Examiner’s rejection with reference to rocking pins 23a have been overcome by the Applicant’s previous arguments and address herein the new rejection based on pins 103a and 103b. In this regard, Applicants previous arguments regarding rocking pin 23a are incorporated herein by reference.

With regard to pins 103a and 103b, Applicant submits that Suzuki was also cited in the corresponding European application as Reference D1, in which pins 103a and 103b were also cited. Applicant further submits that the corresponding European application was granted based on the following comments with regard to Suzuki.

In the embodiment of Figure 16 of Suzuki, the junction (link pin) 103a is situated on the reference plane. However, the link rod 105a and another link rod 104a (see Figures 15 and 16 of Suzuki) are also used. Link rod 104a connects the link 105a with the forceps and therefore can be said to together correspond to a junction of the claimed invention. However, it is evident that the link pin 104a is not situated on the reference plane

from such figures. Therefore, in the device of Fig. 16, the link rod 105a and the link pin 103a correspond to parts of the manipulators, not to the junctions.

Furthermore, junctions (e.g., 23a and 23b) of the claimed invention are rotatably supported by proximal end portions (e.g., 21a and 21b) and are fixed to manipulators (e.g., 9a and 9b). This is self-explanatory from the descriptions of the specification, page 20, line 7 through page 21, line 5 and Figs. 2B and 38.

In comparison, pins 103a and 103b of the reference are fixed to ring rods 105a and 105b. This configures a link structure in which the control rod is not directly fixed to the junction disposed on the proximal end portions.

New dependent claim 23 has also been added to clarify the connection between the above junctions (e.g., 23a and 23b), proximal end portions (e.g., 21a and 21b) and manipulators (e.g., 9a and 9b).

With regard to the rejection of claims 1, 6, 7, 16, 17 and 20 under 35 U.S.C. § 102(a), a medical instrument having the features discussed above and as recited in independent claim 1 is nowhere disclosed in Suzuki. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claim 1 is not anticipated by Suzuki. Accordingly, independent claim 1 patentably distinguishes over Suzuki and is allowable. Claims 6, 7, 16, 17 and 20 being dependent upon claim 1 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 6, 7, 16, 17 and 20 under 35 U.S.C. § 102(a).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

With regard to the rejection of claims 18, 19 and 21 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 18, 19 and 21 are at least allowable therewith as depending from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 18, 19 and 21 under 35 U.S.C. § 103(a).

With regard to the rejection of claim 10 under 35 U.S.C. § 103(a), the same is not rendered obvious by the cited references because neither the Suzuki patent nor the Townsend patent, whether taken alone or in combination, teach or suggest a medical instrument having the features discussed above and recited in independent claim 10. Accordingly, claim 10 patentably distinguishes over the prior art and is allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 10 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,


Edward W. Grolz

Registration No.: 33,705

Scully, Scott, Murphy & Presser P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm